

RE: **RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3738**
FEB -5 -2002

DNK-1997-010-PA-CON2:JBM:139865

AM. Dkt. 4002-2236
PUS MAIL ROOM

#12
(NE)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Bradley J. Coates et al.

Serial No. 09/448,086

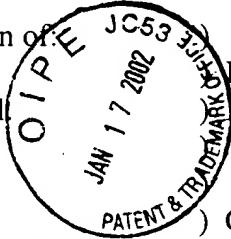
Filed: November 23, 1999

BONE GRAFTS

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Examiner
Isabella
Group Art Unit 3738
Submitted
November 14, 2001

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on November 14, 2001.

JAMES B. MYERS, JR.
Name of Registered Representative
James B. Myers
Signature
November 14 2001
Date of Signature

TERMINAL DISCLAIMER

Hon. Commissioner for Patents
Washington, D. C. 2023
Sir:

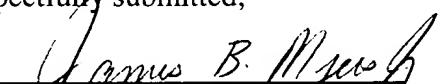
The undersigned hereby represents that the owner, Medtronic Sofamor Danek, Incorporated, has a 100% ownership interest in the above-captioned application and U.S. Patent No. 5,989,289, as indicated by assignment recorded in the U.S. Patent and Trademark Office on August 7, 1998, Reel/Frame 9366/0071 and the copy of the Assignment filed concurrent with this Terminal Disclaimer. The undersigned attorney of record, on behalf of Medtronic Sofamor Danek, Incorporated, hereby disclaims the terminal part of any patent granted on the above-captioned application that would extend beyond the expiration date of U.S. Patent No. 5,989,289, issued November 23, 1999, and hereby agrees that any patent granted on the above-identified patent application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,989,289. This disclaimer shall run with any patent granted on the above-captioned application and to be binding upon the grantees, their successors or assigns.

Coates et al.; USSN 09/448,086
TERMINAL DISCLAIMER
DNK-1997-010-PA-CON2:JBM:139865

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§154 to 156 and 173 of the above-identified patent, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that the granted patent, expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Applicants enclose the statutory fee pursuant to 37 C.F.R. §1.20 (d) of \$110.00. In addition, please provide any extensions of time that may be necessary and charge any fees that may be due to Deposit Account No. 23-3030, but do not include any payment of issue fees that are or may become due.

Respectfully submitted,

By: 
James B. Myers Jr., Reg. No. 42,021
Woodard, Emhardt, Naughton, Moriarty & McNett
Bank One Center Tower
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
(317) 634-3456

T. D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: Sept. 22, 02
TO: EXAMINER Sabella
FROM: Patricia
PARALEGAL SPECIALIST

APPL. S.N.: 09/1448 082
ART UNIT: 38

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: Jan 17, 02

This is an informal, internal memo only. It must not be (1) mailed to applicant nor (2) placed of record in the application file. Please keep this memo attached to the application in order for the rejected T.D. to be reexamined by the paralegal specialist. THANK YOU.

The T.D. is **IMPROPER** and has not been accepted for the reason(s) checked below (see ¶14.24):

- The fee has not been recorded or there is no authorization in the application file for the use of a deposit account (see ¶14.26.07). **FORWARD CASE TO LEGAL INSTRUMENTS EXAMINER/PATENT ANALYST TO HAVE THE FEE CHARGED.**
- The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent (*i.e.*, 100% or in the whole) of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).
- The T.D. lacks the enforceable only during common ownership clause - needed to overcome a double patenting rejection, Rule 321(b) (see ¶ 14.27.01)
- The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).

✓ The person who signed the T.D.:

- ✓ is not listed as an attorney "of record" (see ¶¶ 14.29 and 14.29.01).
- has failed to state his/her capacity to sign for the business entity (see ¶ 14.28),
- is not recognized as an officer of the assignee (see ¶¶ 14.29 & possibly 14.29.02).
- No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
- The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).
- The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
- The serial number of this application (or the number of the patent in the reexam or reissue case(s)) being disclaimed is missing or incorrect (see ¶¶ 14.26, 14.26.04 or 14.26.05).
- The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.27.03).
- Other:
- Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL FOR FY 2001

Patent fees are subject to annual revision.

Total Amount of Payment (\$ 464.00)

Complete if Known

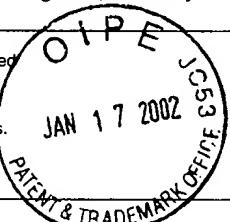
Application Number	09/448,086
Filing Date	November 23, 1999
First Named Inventor	Bradley J. Coates
Group Art Unit	3738
Examiner Name	ISABELLA - 5 2002

COPY OF PAPERS
ORIGINALLY FILED

METHOD OF PAYMENT

FEE CALCULATION (continued)

1. <input type="checkbox"/>	The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:
Deposit Account Number	23-3030
Deposit Account Name	Woodard, Emhardt, Naughton, Moriarty & McNett
<input checked="" type="checkbox"/>	Charge any Additional Fee Required Under 37 CFR 1.16 and 1.17
<input type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27.
2. <input checked="" type="checkbox"/>	Payment Enclosed:
<input checked="" type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> Other	



FEE CALCULATION

1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	710	201	355	Utility Filing Fee	
106	320	206	160	Design Filing Fee	
107	490	207	245	Plant Filing Fee	
108	710	208	355	Reissue Filing Fee	
114	150	214	75	Provisional Filing Fee	
SUBTOTAL (1) (\$)					

2. EXTRA CLAIM FEES

Total Claims	41	-28** =	13	X	18	=	\$234.00
Independent Claims	4	-3** =	1	X	80	=	\$ 80.00
Multiple Dependent							

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent
SUBTOTAL (2) (\$ 314.00)				

**or number previously paid, if greater; For Reissues, see above

3. ADDITIONAL FEES

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	\$40.00
146	710	246	355	Filing a submission after final rejection (37 CFR 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
Other Fee (specify) Terminal Disclaimer					\$ 110.00
* Reduced by Basic Filing Fee Paid					SUBTOTAL (3) (\$ 150.00)

SUBMITTED BY

Complete if applicable

Name (Print/Type)	James B. Myers, Jr.	Registration No. (Attorney/Agent)	42,021	Telephone	(317) 634-3456
Signature	<i>James B. Myers, Jr.</i>			Date	November 14, 2001

Warning: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.